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| 10/624,325 | 07/22/2003 | Wealthy Desai | 9400-34 | 7298 |
| 39072 | 7590 | 06/02/2006 | EXAMINER | |
| MYERS BIGEL SIBLEY & SAJOVEC, P.A. | | | LEVINE, ADAM L | |
| P.O. BOX 37428 | | | ART UNIT | |
| RALEIGH, NC 27627 | | | PAPER NUMBER | |
| | | | 3625 | |

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,325

Applicant(s)

DESAI, WEALTHY

Examiner

Adam Levine

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-32, 34-60 and 62-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-32, 34-60 and 62-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant filed amendments and remarks on October 31, 2005, in response to the office action dated August 1, 2005. In its response, Applicant has amended claims 1, 3, 29, 31, 57, and 59. Applicant has cancelled claims 5, 33, and 61. Claims 1-4, 6-32, 34-60, and 62-84 are examined in this office action. A requirement for information under 37 CFR 1.105 was mailed January 13, 2006. Applicant filed a response to the requirement on March 10, 2006.

Response to Arguments

Applicant's arguments filed October 31, 2005, have been fully considered but they are not persuasive. Applicant argues that the references do not teach or suggest a method as claimed because no pages are provided to indicate what options or functions are provided or initiated when the customer selects "Buy Ads Online." Superpages discloses options and functions such as Add/Modify/Check your listing (see at least U2 p.1), a listing of functions and choices such as "SuperBundles," "Hotlinks," "MerchantMatch," "Web Sites," "Banner Ads," "Super Network Ads," and "Online Coupons," (see at least V2 p.1), these functions and options are further detailed as discussed in the previous action (see at least items W2 through W7).

Applicant argues that the functionality of Superpages differs from the present application, however, this is not established in the claims in any clear way. Although

Applicant argues that some part of the prior art process must occur offline, the entire process could take place online as disclosed by Superpages (see at least V3 p.1). In response to applicant's argument that the present application allows a different level of functionality than the prior art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Unfortunately, arguments that the cited reference does not perform with the same level of functionality as the present invention do not alone distinguish the present claims if the language in the claims does not clearly distinguish the difference.

Applicant argues that the prior art does not disclose "receiving billing information from the customer at the web site." Applicant argues that the information received is merely contact information rather than billing information, however, a quick comparison between the information fields received in the reference (see at least V3 p.1) and in the present application's Figure 11 show that the fields are virtually identical. The information that the prior art receives would also ultimately be used for billing purposes. The prior art therefore discloses receiving billing information at the website.

With regard to "generating a price quote for the business listings ordered by the customer and displaying the price quote to the customer at the website," Applicant

argues that no price quote is apparent in the prior art reference and that the only pricing information displayed is for a given feature or a website, not for a business listing configured and ordered by a customer. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "displaying a price quote for a business listing configured and ordered by a customer") are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In any case, the prior art shows a price quote for a given set of specific options. The customer must choose from among these given sets of options, therefore, the price quotes displayed to the customer do represent the price quotes for the listings ordered by the customer. Each option in the sets of options disclosed in the prior art is configurable within the same price package (see at least W4). The Examiner suggests that incorporating a greater degree of the functionality of the present application into the claims might be helpful. For example, the prior art clearly lists price quotes for listing enhancements that can be chosen by the customer at the website. Specifying clear and distinct limitations that enable a more extensive customization, incorporating multiple enhancements that are not part of a pre-configured package, all taking place during "real-time" (i.e., during a current online session), and all clearly taking place through the website, without human interaction on the part of the directory provider, would help clarify the nature of the invention. It is possible that these clarifications could distinguish the present application from

Superpages. Even were this the case, however, the additional prior art noted below could still anticipate or make obvious the present application, and in any case, an additional prior art search would be necessary.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4,6-32, 34-60, and 62-84 are rejected under 35 U.S.C. 102(b) as being anticipated by Superpages (a collection of prior art cited in Paper # 050715, PTO-892, Items U1-X7). See MPEP §2131.01.

Superpages teaches all the limitations of Claims 1-4,6-32, 34-60, and 62-84. For example, Superpages discloses providing a Web site accessible by a customer and receiving a request from the customer at the Web site to place the order for the listing of a business in a business directory (see at least U1 pp.1-2, V3 pp. 1-2, and U6 p.1; Please note: V3 and U6 show that these features are inherent in U1. Please note that

throughout this Non-Final Office Action, Items W1-X7, when cited, are used to show the inherency of each element in Items U1 and V1. Items U1 and V1 are versions of the same homepage differing only in the date on which they were recorded. Items W1-X7 are more detailed sub pages accessible through the homepage. V1 is a more complete copy of the homepage, and its early date shows that the functional elements detailed in items W1-X7 were present as of June 28, 2001, however, because not all of the webpages shown as items W1-X7 are dated prior to June 28, 2001, Item U1 is being used to show the total state of the enabled business directory website at least as early as its date, July 20, 2002, the latest date of all the reference materials listed on the form PTO-892 included herewith). Superpages further discloses:

- displaying at the Web site a list of available optional listing enhancements and receiving a request from the customer at the Web site to include in the listing of the business in the business directory at least one optional listing enhancement from the list of available optional listing enhancements (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2); receiving a request from the customer at the Web site to place the order for the listing of a business in a business directory including the at least one optional listing enhancement requested by the customer (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2).
- the business directory is a classified business directory (see at least U1 pp.1-2, V1 pp.1-2, W1 p.1, and X5 pp.1-2).

- displaying to the customer at the Web site a solicitation to enhance the listing with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2); receiving listing information from the customer at the Web site, wherein the listing information includes basic business information (see at least U1 pp.1-2, W3 p.1-4, X3 p.1).
- receiving listing information from the customer at the Web site, the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: basic business information including a business name, a business address, and a business telephone number, business market information including a region or market in which the customer wishes the business listing to appear, business category information including at least one business category under which the customer wishes to list the business in the business directory, also providing for at least two categories under which the customer wishes to list the business in the business directory; displaying at the Web site a list of available business categories and subcategories and receiving from the customer at the Web site a selection of a business category and subcategory from the list of available business categories and subcategories (see at least

U1 pp.1-2, X1 p. 1-2, U2 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, X3 p.1, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2, X4 pp.1-2, V5 pp.1-6, W6 p.1).

- receiving listing information from the customer at the Web site, the listing information including at least one of business market information, business category information and optional listing enhancement information relating to the placement and/or appearance of the listing in the business directory: including optional listing enhancement information that includes graphical and/or textual indicia the customer wishes to appear on the listing in the business directory, the graphical and/or textual indicia including at least one of a customer Web site link, a customer email link, enhanced text, listing highlighting, and a link to a supplemental listing, including a link to an enhanced listing, further including receiving supplemental information from the customer at the Web site that the customer wishes to be displayed when the link to the supplemental listing is accessed by a directory user; and also including receiving enhanced text information from the customer at the Web site that the customer wishes to appear on the listing in the business directory (see at least U1 pp.1-2, U2 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, X3 p.1, X4 pp.1-2, V5 pp.1-6).
- receiving billing information from the customer at the Web site (see at least U1 pp.1-2, V3 pp. 1-2).
- generating a price quote for the business listing ordered by the customer and displaying the price quote to the customer at the Web site; calculating the

price quote based on features requested by the customer to be included in the business listing (see at least U1 pp.1-2, U2 pp.1-2, V2 pp.1-2, U3 p.1, W4 p.1-2).

- displaying a statement of terms and conditions to the customer at the Web site and receiving confirmation of acceptance of the terms and conditions from the customer at the Web site (see at least U1 pp.1-2, V5 pp.1-6, W5 pp.1-6, X6 pp.1-4, U7 pp.1-6, W7 pp.1-3).
- generating an order confirmation and displaying it to the customer at the Web site (see at least U1 pp.1-2, X3 p.1, Please note: it is an inherent aspect of the "Buy Ads Online" option and the option to see how the listing appears that the order confirmation would then be displayed to the customer, at least in the form of showing the customer's listing).
- the order serving to provide enhancements to an existing business listing in the business directory (see at least U1 pp.1-2, W3 pp.1-4, X3 p.1, V4 pp.1-2, U6 p.1, V7 p.1, X7 p.1).
- business directory is an online business directory (see at least U1 pp.1-2).
- sending the customer an email including information regarding the order for the listing in the business directory (see at least U1 pp.1-2, V3 pp.1-2).

Pertaining to system Claims 29-56

Rejection of Claims 29-56 is based on the same rationale as noted above (Please note: the means for accomplishing each step of the method, as disclosed in the Superpages reference noted above, is either disclosed or inherent in each specific

section of the reference that discloses the step in the method. For example, the means for receiving a request from the customer at the Web site to place the order for the listing of the business in the business directory is disclosed in Superpages (see at least U1 pp.1-2, V3 pp. 1-2, and U6 p.1) in the form of the webpages themselves, while the means for displaying to the customer at the Web site a solicitation to enhance the listing with at least one optional listing enhancement, wherein the at least one optional listing enhancement can be purchased with an associated fee is inherent in the webpages disclosed in Superpages (see at least U1 pp.1-2, V2 pp.1-2, W2 pp.1-2, X2 pp.1-2, U3 p.1, W3 pp.1-4, U4 pp.1-2, W4 pp.1-2) because they must be displayed to the customer in order to achieve their essential function.

Pertaining to computer program product Claims 57-84

Rejection of Claims 57-84 is based on the same rationale as noted above (Please note: the computer program product and computer readable storage medium having computer readable program code embodied in the medium configured to accomplish each step of the method, as disclosed in the Superpages reference noted above, is inherent in each specific section of the reference that discloses the step in the method. For example, the computer program product for receiving an order for a listing of a business in a business directory comprising a computer readable storage medium having computer readable program code embodied in the medium, the computer readable program code comprising computer readable program code configured to provide a Web site accessible by a customer, and computer readable program code configured to receive a request from the customer at the Web site to place the order for

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the listing of the business in the business directory is inherent in the webpages and method steps disclosed in Superpages (see at least U1 pp.1-2, V3 pp. 1-2, and U6 p.1) because without those elements the webpages could not exist.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- "Switchboard and Intuit Partner to Extend Site Builder Program; Switchboard to Add Small Business Web Sites to Its Local Merchant Network." January 24, 2000. EDGE: Work-Group Computing Report. Teaches enabling a web directory for local businesses including the incorporation of multiple functions and referral links.
- "Homestead Technologies and Switchboard Team Up to Make Online Yellow Page Ads Available to Small Business Members." April 25, 2001. PR Newswire. Teaches enabling the creation of customized online yellow pages displays through a self service web interface.
- "FunYellow.com Launches America's First Fun Animated Yellow Pages; Unique FunTV Lets Any Business Easily Create a Free Animated Commercial." February 1, 2000. Business Wire. Teaches enabling the creation of an animated commercial through a browser. Categorizes businesses by industry in an online directory. Plays the commercial when a customer looks up the business that created the commercial in the online yellow pages.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adam Levine
Patent Examiner
May 29, 2006



Robert M. Pond
Primary Examiner